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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/520,031

08/15/2005

Matthew Marton

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20583

7590

08/28/2008

JONES DAY

222 EAST 41ST ST

NEW YORK, NY 10017

EXAMINER

KIM, YOUNG J

ART UNIT

PAPER NUMBER

1637

MAIL DATE

DELIVERY MODE

08/28/2008

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b> 10/520,031	<b>Applicant(s)</b> MARTON ET AL.	
	<b>Examiner</b> Young J. Kim	<b>Art Unit</b> 1637	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 27 May 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 6,8-10,37,40,42,43,46-50 and 53-57 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 40,42,43,46-50 and 53-55 is/are allowed.
- 6) ☒ Claim(s) 6,8-10,37,56 and 57 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |  |   |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                       | 4) <input type="checkbox"/> Interview Summary (PTO-413)           |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | Paper No(s)/Mail Date. _____                                      |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date <u>5/27/2008</u> .   | 6) <input type="checkbox"/> Other: _____                          |

### **DETAILED ACTION**

The present Office Action is responsive to the Amendment received on May 27, 2008.

#### ***Preliminary Remark***

Claims 1-5, 7, 11-36, 38, 39, 41, 44, 45, 51, and 52 are canceled.

Claims 55-57 are new.

Claims 6, 8-10, 37, 40, 42, 43, 46-50, and 53-57 are pending and are under prosecution herein.

#### ***Information Disclosure Statement***

The IDS received May 27, 2008 is proper and is being considered by the Examiner.

#### ***Claim Objections***

The objection of claims 47-53 as being a substantial duplicate of claims 5, 7, and 42-46, made in the Office Action mailed on November 28, 2007 is withdrawn in view of the Amendment received on May 27, 2008. Specifically, claims 5, 7, 44, 45, 51, and 52 have been canceled.

The dependency of claims 42, 43, and 46 have been changed to depend from claim 40.

Therefore, the amendment overcomes the objection of record.

#### ***Claim Rejections - 35 USC § 112***

The rejection of claims 6, 8-10, 37-40, and 45-54 under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter, made in the Office Action mailed on November 28, 2007 is withdrawn in view of the Amendment received on May 27, 2008.

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***Rejection, New Grounds - Necessitated by Amendment***

The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 6, 8-10, 37, 56, and 57 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 6 is indefinite for reciting the phrase, "said plurality of control probes that differ in the number of said monomers."

Claim 6, step (a) has been amended to recite that the quality control probes now "optionally" further comprises a first sequence contiguous with the predetermined binding sequences.

Step (a) of claim 6 only recites that the probe comprises either the same predetermined binding sequences or different predetermined binding sequences having the same binding specificity. Neither limitations provide any antecedent basis for the quality control probes that differ in the number of the monomers.

Therefore, claim 6, step (b) which now implicitly requires the limitation preceded by the language, "optionally" renders the entire scope of the claim indefinite.

Claims 8-10 and 37 are indefinite by way of their dependency on claim 6.

Claim 56 is indefinite analogously.

In addition, claim 56 is indefinite for the recitation of the phrase, "each of said plurality of quality control probes optionally further optionally comprises a first sequence contiguous with said predetermined binding sequence..."

It is respectfully submitted that the above-cited limitation is not understood.

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For the purpose of prosecution, the latter instance of the term, "optionally" has been treated as arising from a typographical error.

Claim 57 is indefinite by way of its dependency on claim 56.

***Claim Rejections - 35 USC § 102***

The rejection of claims 5, 6, 9, 42, 47, 48, and 54 under 35 U.S.C. 102(b) as being anticipated by Hubbell et al. (U.S. Patent No. 6,130,046, issued October 10, 2000), made in the Office Action mailed on November 28, 2007 is withdrawn in view of the Amendment received on May 27, 2008.

With regard to the rejection of claims 6, 9, 42, 47, 48, and 54, Hubbell et al. do not explicitly teach that the control probes differ in the number of monomers, as the artisans employ control probes of the same length (i.e., same number of monomers). The rejection of claim 5 is withdrawn in view of its cancellation.

***Claim Rejections - 35 USC § 103***

The rejection of claims 7, 8, 10, 43, 49, and 53 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hubbell et al. (U.S. Patent No. 6,130,046, issued October 10, 2000) in view of Lockhart et al. (U.S. Patent No. 6,040,138, issued March 21, 2000), made in the Office Action mailed on November 28, 2007 is withdrawn in view of the Amendment received on May 27, 2008.

With regard to the rejection of claims 8, 10, 43, 49, and 53, Lockhart et al. do not cure the deficiencies of Hubbell et al., and thus the rejection must fall.

The rejection of claim 7 is withdrawn in view of its cancellation.

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The rejection of claims 37-40, 44-46, and 50-52 under 35 U.S.C. 103(a) as being unpatentable over Hubbell et al. (U.S. Patent No. 6,130,046, issued October 10, 2000) in view of Fisher et al. (U.S. Patent No. 6,232,072, issued May 5, 2001), made in the Office Action mailed on November 28, 2007 is withdrawn in view of the Amendment received on May 27, 2008.

With regard to the rejection of claims 37, 40, 46, and 50, Fisher et al. do not cure the deficiencies of Hubbell et al., and thus, the rejection must fall.

The rejection of claims 38, 39, 44, 45, 51, and 52 is withdrawn in view of their cancellation.

### ***Conclusion***

The prior art rejection has been withdrawn in view of Applicants' amendment and arguments presented.

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

### ***Inquiries***

Any inquiry concerning this communication or earlier communications from the Examiner should be directed to Young J. Kim whose telephone number is (571) 272-0785. The Examiner is on flex-time schedule and can best be reached from 8:30 a.m. to 4:30 p.m (M-W and F). The Examiner can also be reached via e-mail to Young.Kim@uspto.gov. However, the office cannot guarantee security through the e-mail system nor should official papers be transmitted through this route.

If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Dr. Gary Benzion, can be reached at (571) 272-0782.

Papers related to this application may be submitted to Art Unit 1637 by facsimile transmission. The faxing of such papers must conform with the notice published in the Official Gazette, 1156 OG 61 (November 16, 1993) and 1157 OG 94 (December 28, 1993) (see 37 CFR 1.6(d)). NOTE: If applicant does submit a paper by FAX, the original copy should be retained by applicant or applicant's representative. NO DUPLICATE COPIES SHOULD BE SUBMITTED, so as to avoid the processing of duplicate papers in the Office. All official documents must be sent to the Official Tech Center Fax number: (571) 273-8300. For Unofficial documents, faxes can be sent directly to the Examiner at (571) 273-0785. Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (571) 272-1600.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system,

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contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Young J. Kim/  
Primary Examiner  
Art Unit 1637  
8/28/2008

/YJK/